

Docket No.: CISCO-3550

REMARKS

In the Office action dated February 2, 2005, a restriction requirement was made. Applicant elects claims 1-5, 12-16, 19-22, and 25-29, and withdraws the remaining claims. The abstract was objected to as exceeding 150 words; Applicant submits herein amendments to the Abstract reducing its length to 138 words. Page 12, lines 12-15 was objected to based on an incomplete reference. Applicant herein amends the specification at this part to correct this reference.

Claim 12 was rejected under 35 USC 102(e) as being anticipated by Fee et al. U.S. Patent 6,415,314. Claim 12 is cancelled herein and its limitations added to claim 13.

Claims 1-4, 13-16, 19-22 and 25-28 were rejected under 35 USC 103(a) as being unpatentable over Fee in view of Cole, US patent 5,854,901. Applicant respectfully traverses this rejection.

Applicant asserts that the Examiner has failed to make a prima facie showing of obviousness. The third requirement of an obviousness rejection under 35 USC 103(a) as explicitly stated in MPEP 2143, that the prior art references must teach or suggest all the claim limitations.

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With respect to the independent claims 1, 13, 19 and 25(all pending independent claims), the Examiner has failed to show where the prior art teaches, discloses or otherwise suggests the claimed limitation of verifying that a system switch processor ("SSP") has been assigned an IP address. While the Examiner cites Cole at column 4, lines 23-32, this portion of Cole reads (emphasis added):

After identifying the "new-router.cisco.com" DNS packet, the router initiates an IP address discovery process. The discovery process determines whether proposed IP addresses are available for use by the router. The router 24 uses ARP requests to determine the availability of a proposed IP address. Accordingly, transaction 52 transmits ARP request packets 28 over the network segment 20. Each ARP request packet 28 includes a proposed IP address derived from the source address 36 as described in detail below.

Specifically, the discovery process of Cole determines whether proposed IP addresses are available for use by a router. This is not the same as determining that a system switch processor has been assigned an IP address. As explained in the very portion of Cole cited by the Examiner, the IP addresses Cole considers to be "proposed IP addresses" are not assigned to the router, but are part of the source address.


In order to support an anticipation rejection based on inherency, an Examiner must provide factual and technical grounds establishing that the inherent feature necessarily

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flows from the teachings of the prior art. Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); In re Oelrich, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (holding that inherency must flow as a necessary conclusion from the prior art, not simply a possible one). Applicants submit that the Examiner has not made a prima facie case of anticipation of the present claims based on inherency because there is no showing that the portions of the cited prior art show the limitation of verifying that a system switch processor has been assigned an IP address.

If the Examiner has any questions regarding this application or this response, the Examiner is requested to telephone the undersigned at 775-586-9500.

Respectfully submitted,
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